



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,353	11/26/2001	Erik G. Burrows	2099A	9897

30408 7590 11/17/2004

GATEWAY, INC.  
ATTN: SCOTT CHARLES RICHARDSON  
610 GATEWAY DR., Y-04  
N. SIOUX CITY, SD 57049

EXAMINER

SORRELL, ERON J

ART UNIT	PAPER NUMBER
----------	--------------

2182

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/994,353		BURROWS, ERIK G.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Eron J Sorrell		2182	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/23/02</u> .   | 6) <input type="checkbox"/> Other: ____                                     |

Art Unit: 2182

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994; a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1,4-8,11-15, and 18-21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4,6-10,12-16 and 18 of copending Application No. 09/919,556. Although the conflicting claims are not identical, they are not patentably distinct from each other because the independent claims of the instant application have a positive recitation of "receiving a selection of one of said available features from said list," whereas application 09/919,556 necessarily implies a reception of a selected feature in the limitation "analyzing a **selected feature** to be operable from said list (emphasis added)." A

Art Unit: 2182

selection of a feature from a list of features would have to be received before analyzing a selected feature can take place.

The listed dependent claims are identical.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1,2,4-9,11-16,18-23, and 25-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Chen et al. (US 2003/0028650 hereinafter "Chen").

5. Referring to method claim 1, program on readable medium claim 8, and system claim 15, Chen teaches a method and system for assigning Internet Protocol (IP) addresses, comprising:

Art Unit: 2182

identifying hosts present within a local network (see paragraph 76 on page 7);

providing a list of available features for at least one host within said local network (see paragraphs 79-80 of page 7);

receiving a selection of one of said available features from said list (see paragraphs 79-80 of page 7);

analyzing if said selected feature requires a static IP address to be assigned to said at least one host (see paragraphs 79-80 of page 7 and paragraph 85 of page 8); and

assigning an IP address to said at least one host, wherein a static IP address is assigned to said at least one host if said selected feature requires said static IP address (see figures 8 and 14 and paragraph 85 on page 8).

6. Referring to system claim 22, Chen teaches, in a local network of one or more hosts, a system for assigning Internet Protocol (IP) addresses, comprising:

a processor (see item labeled 440 in figure 4);

a memory coupled to said processor, wherein said memory is capable of storing a list of available features for at least one host within the local network (see items labeled 485 and 490 in figure 4);

Art Unit: 2182

a display coupled to said processor, wherein said display is capable of providing said list of available features to a user (see item labeled 450 in figure 4 and figure 8);

an input device coupled to said processor, wherein said input device is capable of receiving a selection by said user of one of said available features from said list (see item labeled 410 in figure 4); and

logic capable of being executed by the processor, wherein said logic is capable of identifying hosts present within a local network, analyzing if said feature selected by said user requires a static IP address to be assigned to said at least one host, and assigning an IP address to said at least one host, wherein a static IP address is assigned to said at least one host if said selected feature requires said static IP address (see paragraphs 79-85 of pages 7 and 8).

7. Referring to method claim 2, program on readable medium claim 9, and system claims 16 and 23, Chen teaches a dynamic IP address is assigned to said at least one host if said selected feature does not require said static IP address to be assigned to said at least one host (see paragraph 86 on page 8).

Art Unit: 2182

8. Referring to method claim 4, program on readable medium claim 11, and system claims 18 and 25, Chen teaches the list is provided in a graphical user interface (see paragraphs 79-80 on page 7).

9. Referring to method claim 5, program on readable medium claim 12, and system claims 19 and 26, Chen teaches the selected feature is capable of being selected by a user utilizing said graphical user interface (see paragraphs 79-80 on page 7).

10. Referring to method claim 6, program on readable medium claim 13, and system claims 20 and 27, Chen teaches the assigning of said IP address is in accordance with Dynamic Host Configuration Protocol (see paragraph 80 if page 7).

11. Referring to method claim 7, program on readable medium claim 14, and system claims 21 and 28, Chen teaches returning the static IP address to a pool of available IP addresses if said selected feature requiring said static IP address is disabled (see paragraph 68 on page 6).

Art Unit: 2182

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 3,10,17, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of Wang et al. (U.S. Patent No. 6,496,511 hereinafter "Wang").

14. Referring to method claim 3, program on readable medium claim 10, and system claims 17 and 24, Chen fails to disclose the limitation the static IP address being assigned from a pool of available static IP addresses and the dynamic IP address is assigned from a pool of available dynamic addresses.

Wang teaches, in an analogous system and method, the above limitation (see line 50 of column 2 to line 11 of column 3).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the method and system of Chen with the above teachings of Wang. One of ordinary skill in the art would have been motivated to make



Art Unit: 2182

such modification in order to reserve predetermined IP addresses in a fixed IP address pool for the uses to which they've been assigned as suggested by Wang (see lines 35-47 of column 2).

### ***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following references are cited to further show the state of the art as it pertains to IP address assignment in a network:

US 2003/0195954 to Bahlmann teaches distinguishing when to configure a device with a static or dynamic IP address;

US Patent 6,289,378 to Meyer et al. teaches a system wherein computers are configured by another computer on a local area network via a graphical user interface.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eron J Sorrell whose telephone number is 571 272-4160. The examiner can normally be reached on Monday-Friday 9:00AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A Gaffin can be reached on 571 272-4146. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2182

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EJS  
November 9, 2004



TECHNOLOGY CENTER  
SUPERVISOR/EXAMINER  
TECHNOLOGY CENTER 2100